

## **REMARKS**

Claims 1-19, 21-33, 40, and 41 are currently pending. By this Amendment, Claims 1, 10, 11, 14, 15, 21, 22, 25, 28, 29, and 41 have been amended, Claims 3, 13, and 27 have been cancelled, and no new claims have been added. Thus, Claims 1, 2, 4-12, 14-19, 21-26, 28-33, 40, and 41 are currently at issue.

### **I. Anticipation Rejections Over Shelver**

In Paragraph 2 of the Office Action, the Examiner rejected Claims 1-9, 33, and 40 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,889,434 to Shelver ("Shelver"). Shelver discloses a window having two panes (138,139) of glass held by an adapter strip (120) having a mastic sealing material (131) therein. (Shelver, Col. 3, Lines 47-56; Col. 5, Lines 17-26). The adapter strip (120) is a strip of extruded aluminum having two edges (121,122) and a tongue (130). (Shelver, Col. 5, Lines 33-40). The tongue (130) engages the window frame to attach the adapter (120) to the frame, and the adapter (120) extends completely around the inside of the window frame. (Shelver, Col. 3, Lines 56-62; FIG. 3).

In order for a reference to constitute a §102(b) bar to patentability, the reference must disclose each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983). It is well-settled law that the burden of establishing a *prima facie* case of anticipation resides with the Patent & Trademark Office. *Ex Parte Skinner*, 2 U.S.P.Q. 2d 1788 (BPAI 1986).

#### **A. Claims 1-9**

Claim 1 includes, among other elements, "a connector extending from the base and configured to engage the muntin bar end." Applicant respectfully submits that Shelver does not disclose, teach, or suggest this element of Claim 1.

Applicant maintains its position that the tongue (130) of the adapter strip (120) of Shelver is not configured for, or capable of, engaging a muntin bar end. Shelver does not disclose a muntin bar end at all. Rather, the tongue (130) is configured for engaging the window frame and

cannot engage a muntin bar end, because if a muntin bar were present, it would be on the opposite side of the adapter strip (120) as the tongue (130). Thus, the tongue (130) of Shelver cannot be considered to be the “connector” recited in Claim 1, as asserted by the Examiner. In response to the Examiner’s question “what would prevent Shelver’s connector from being able to be inserted in to a muntin bar end,” Applicant responds that the adapter strip (120) of Shelver extends the entire width of the window assembly. In order to be inserted into a muntin bar end, as the muntin clip recited in claim 1, the muntin bar would need to be as wide as the window assembly, at which point it would cease to be a “muntin bar,” because it would not be able to separate window sections, which is a central characteristic of a muntin bar. Accordingly, whether there are structural differences between Applicant’s claimed structure and the adapter strip (120) disclosed in Shelver is irrelevant, because the structure of Shelver is not capable of performing the recited use. Rendering the adapter strip of Shelver capable of performing the recited use would require modification of the disclosed structure, which is not permissible in the context of a §102 rejection. Applicant restates that the Examiner still has not provided any specific explanation of how the adapter strip (120) of Shelver could engage, or would be capable of engaging, any known or existing muntin bar end, and respectfully submits that a *prima facie* case of anticipation cannot be met without such explanation. Accordingly, Shelver does not disclose, teach, or suggest the above element of Claim 1, and Shelver cannot anticipate Claim 1.

Additionally, Applicant restates its argument that the adapter strip (120) of Shelver does not fall within the scope of amended Claim 1 because the adapter strip (120) is not a “muntin clip.” Shelver does not disclose a muntin clip at all. Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunrace Roots Enter. Co. v. SRAM Co.*, 336 F.3d 1298, 1302, 67 U.S.P.Q.2d 1438, 1441 (Fed. Cir. 2003). Muntin clips are widely known and used in the window art, and the customary meaning of “muntin clip” used by those skilled in the art does not encompass the adapter strip (120) disclosed in Shelver. Applicant restates that the Examiner has not explained how a structure could reasonably be considered to be a “muntin clip” when: (A) It is never described anywhere in the specification of Shelver as a “muntin clip,” and (B) It does not fit within any definition of “muntin clip” used by those skilled in the art. The Examiner’s position requires the

term “a muntin clip” to be interpreted to mean “a structure,” which is improper, because it strips the claim term of all meaning. Thus, because Shelver does not disclose a muntin clip, Shelver cannot anticipate Claim 1.

Claims 2 and 4-9 depend from Claim 1 and contain all the elements of Claim 1. Thus, for the reasons stated above with respect to Claim 1, Shelver does not disclose, teach, or suggest all the elements of Claims 2 and 4-9, and Shelver cannot anticipate Claims 2 and 4-9.

**B. Claim 33**

Claim 33 includes, among other elements, “a connector extending perpendicularly from the second side of the base and configured to be inserted into the muntin bar end and engage the inner walls of the muntin bar end such that the entire muntin clip is between the panes of glass.” Applicant respectfully submits that Shelver does not disclose, teach, or suggest this element of Claim 33.

As stated before and stated above with respect to Claim 1, Shelver does not disclose, teach, or suggest any connection to a muntin bar end or any ability to connect to a muntin bar end. The tongue (130) of Shelver engages a window frame, rather than a muntin bar end. Additionally, Shelver does not disclose, teach, or suggest that the tongue (130) can be inserted into a muntin bar end and engage the inner walls of the muntin bar end. In fact, because the tongue (130) of Shelver stretches for the entire length of the window frame, it is highly unlikely that it could be inserted into any known muntin bar end without modification. Further, the edges of the adapter strip (120) of Shelver are located on the outside of the window panes (138,139). This is necessary for the adapter strip (120) to hold the window panes (138,139). Therefore, the tongue (130) of Shelver is not configured for engaging a muntin bar end “such that the entire muntin clip is between the panes of glass.” Applicant also restates that the Examiner has not shown the adapter strip (120) of Shelver to be capable of performing the recited function, which Applicant submits is necessary for establishing a *prima facie* case of anticipation. Thus, for the reasons stated above with respect to Claim 1, Shelver does not disclose, teach, or suggest this element of Claim 33, and Shelver cannot anticipate Claim 33.

Further, like Claim 1, Claim 33 recites a “muntin clip.” As stated above with respect to Claim 1, the adapter strip (120) of Shelver does not fall within the scope of amended Claim 33 because the adapter strip (120) is not a “muntin clip.” Further, the Examiner has not explained how or why the adapter strip (120) of Shelver could be considered a “muntin clip.” Thus, for this additional reason, Shelver cannot anticipate Claim 33.

## **II. Anticipation Rejections Over Merchlewitz**

In Paragraph 3 of the Office Action, the Examiner rejected Claim 10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,899,033 to Merchlewitz (“Merchlewitz”). Merchlewitz discloses a carrier member (20) having an extending pin portion (82) with a series of barbs (84) extending therefrom, which is inserted into a muntin bar (22). (Merchlewitz, Col. 5, Lines 1-20; FIG. 2).

Claim 10, as amended, includes, among other elements, “a base having a plurality of protrusions creating a textured surface.” Applicant submits that Merchlewitz does not disclose a textured surface created by a plurality of protrusions. First, Applicant respectfully submits that “textured” is a well-known term in the art, and does not mean simply that the article has a texture. The Examiner is correct that every surface inherently has a texture. Rather, “textured” implies that a tactile, functional texture has been applied to the surface in question. Thus, Applicant submits that Merchlewitz does not disclose a textured surface. Additionally, Applicants have amended Claim 10 to recite that the textured surface is created by a plurality of protrusions. Even if the Examiner considers a surface of the member (20) of Merchlewitz to be “textured,” there is no disclosure, teaching, or suggestion in Merchlewitz of having a textured surface created by a plurality of protrusions. Thus, Merchlewitz cannot anticipate Claim 10.

Claim 10 also includes, among other elements, “the textured surface adapted to frictionally engage the separator.” The member (20) and muntin bar (22) of Merchlewitz are disclosed for use with a single-pane window assembly. Thus, no pane separator is disclosed in Merchlewitz, and no structural feature of the member (20) is adapted to engage a pane separator. Thus, for this additional reason, Merchlewitz does not anticipate claim 10.

### **III. Anticipation Rejections Over Gieseke**

In Paragraph 4 of the Office Action, the Examiner rejected Claims 11-13 and 16-17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,131,356 to Gieseke ("Gieseke"). Additionally, in Paragraph 6 of the Office Action, the Examiner rejected Claims 25-27 and 30-32 under 35 U.S.C. § 102(b) as being anticipated by Gieseke. Gieseke discloses a muntin bar clip (1) having a tip (40) that includes an offset (30) and either one or more prongs (45) (FIG. 1) or a generally planar blunt end (50) (FIG. 2) to engage a spacer (84). (Gieseke, Col. 3, Lines 39-47; Col. 4, Lines 10-16). The clip (1) is secured to the spacer (84) by sandwiching the prongs (45) or the blunt end (50) between the spacer (84) and the pane (71). (Gieseke, FIG. 5). The muntin bar clip (1) also has a post (10) extending from the tip (40), having fastener means (20) and adapted to be inserted into a muntin bar end (65). (Gieseke, Col. 4, Lines 1-16).

#### **A. Claims 11-17**

Claim 11, as amended, includes, among other elements, "a muntin clip ... having a base having a first surface being textured for frictionally engaging the separator." Gieseke does not disclose this element of claim 11. In particular, Gieseke does not disclose a textured surface that frictionally engages the separator, nor any textured surface at all. Rather, all surfaces of the tip (40) of the clip (1) of the '845 patent appear to have smooth surfaces. (See FIGS. 1-11). As stated above, "textured" is a well-known term in the art, and does not mean simply that the article has a texture. Rather, "textured" implies that a tactile, functional texture has been applied to the surface in question. Gieseke discloses no such textured surface. Thus, Gieseke does not disclose this element of claim 11, and cannot anticipate claim 11.

Gieseke also cannot anticipate claims 12, 16, and 17, because claims 12, 16, and 17 depend from claim 11 and include all the elements of claim 11.

**B. Claims 25-27 and 30-32**

Claim 25, as amended, includes, among other elements, “a muntin clip comprising a base having a first surface being textured and adapted to frictionally engage the separator.” As stated above with respect to Claim 11, Gieseke does not disclose a muntin clip having a textured surface as recited in Claim 25. Thus, for the same reasons, Gieseke cannot anticipate claim 25.

Gieseke also cannot anticipate claims 26 and 30-32, because claims 26 and 30-32 depend from claim 26 and include all the elements of claim 26.

**IV. Anticipation Rejections Over Reichert**

In Paragraph 5 of the Office Action, the Examiner rejected Claims 11-17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2001/0034990 to Reichert (“Reichert”). Additionally, in Paragraph 7 of the Office Action, the Examiner rejected Claims 25-32 under 35 U.S.C. § 102(b) as being anticipated by Reichert.

**A. Claims 11-17**

Claim 11, as amended, includes, among other elements, “a muntin clip ... having a base having a first surface being textured for frictionally engaging the separator.” Reichert does not disclose this element of amended Claim 11. As asserted by the Examiner, Reichert shows a window assembly having two panes of glass (18,20) separated by a pane separator (22), and a muntin grid having muntin clips (50) attached to muntin bars (42). However, Reichert does not disclose that the clip has a textured surface for frictionally engaging the separator (22). As stated above, “textured” is a well-known term in the art, and does not mean simply that the article has a texture. Rather, “textured” implies that a tactile, functional texture has been applied to the surface in question. Reichert discloses no such textured surface. Accordingly, Reichert cannot anticipate Claim 11.

Reichert also cannot anticipate claims 12 and 14-17, because claims 12 and 14-17 depend from claim 11 and include all the elements of claim 11. Further, with respect to claims 14 and 15, the Examiner’s positions are inconsistent. The hooks (54) are themselves the structures that engage the pane separator (22) in Reichert. These hooks (54) cannot be both the surface that engages the pane separator and the claimed protrusions on said surface. Further, with respect to

the amendments to claims 14 and 15, the hooks (54) do not “create” a textured surface, and thus, cannot constitute the claimed protrusions. Thus, for these additional reasons, Reichert cannot anticipate Claims 14 and 15.

**B. Claims 25-32**

Claim 25, as amended, includes, among other elements, “a muntin clip comprising a base having a first surface being textured and adapted to frictionally engage the separator.” As stated above with respect to Claim 11, Reichert does not disclose a muntin clip having a textured surface as recited in Claim 25. Thus, for the same reasons, Reichert cannot anticipate claim 25.

Reichert also cannot anticipate claims 26 and 28-32, because claims 26 and 28-32 depend from claim 25 and include all the elements of claim 25. Further, Applicant’s arguments with respect to Claims 14 and 15 above apply equally to claims 28 and 29.

**V. Obviousness Rejections Over Reichert in view of Pease III**

In Paragraph 9 of the Office Action, the Examiner rejected Claim 41 under 35 U.S.C. § 103(a) as being obvious over Reichert in view of U.S. Patent No. 5,834,124 to Pease III *et al.* (“Pease III”). Additionally, in Paragraph 10 of the Office Action, the Examiner rejected Claims 18-19 and 21-24 under 35 U.S.C. § 103(a) as being obvious over Reichert in view of Pease III.

**A. Claim 41**

Claim 41, as amended, includes, among other elements, “a muntin clip ... having a base having a first surface that is textured and that frictionally engages the separator, the textured first surface created by plurality of protrusions thereon.” Applicant submits that the cited references, alone or in combination, do not disclose, teach, or suggest this element of Claim 41. As stated above with respect to Claim 11, Reichert does not disclose a muntin clip having a textured surface as recited in Claim 41. Further, as stated above with respect to Claims 14 and 15, even if the Examiner considers a surface of Reichert to be textured, Reichert does not disclose any textured surface created by a plurality of protrusions thereon. Pease III also does not disclose any of these elements of Claim 41, and the Examiner does not assert otherwise in the Office

Action. Thus, the cited references do not disclose at least these elements of claim 41, and no *prima facie* case of obviousness has been established with respect to claim 41.

**B. Claims 18-19 and 21-24**

Claim 18 includes, among other elements, “a muntin clip ... having a base with a first surface being textured to frictionally engage the pane separator.” Applicant submits that the cited references, alone or in combination, do not disclose, teach, or suggest this element of Claim 18. As stated above with respect to Claim 11, Reichert does not disclose a muntin clip having a textured surface as recited in Claim 18. Pease III also does not disclose this element of Claim 18, and the Examiner does not assert otherwise in the Office Action. Thus, the cited references do not disclose at least this element of claim 18, and no *prima facie* case of obviousness has been established with respect to claim 18.

Additionally, no *prima facie* case of obviousness has been established with respect to Claims 19 and 21-24, because claims 19 and 21-24 depend from claim 18 and include all the elements of claim 26. Further, Applicant’s arguments with respect to Claims 14 and 15 above apply equally to claims 21 and 22.



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**CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration of the Examiner's rejections and allowance of Claims 1, 2, 4-12, 14-19, 21-26, 28-33, 40, and 41 in the present Application. Applicant submits that the Application is in condition for allowance and respectfully requests an early notice of the same.

Please charge any necessary fees to our Deposit Account No. 19-0733.

Respectfully submitted,

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